REMARKS

Claims 29-62 are pending in the application with entry of this Amendment. Reconsideration and allowance of the application, as amended, are respectfully requested assuming the Office considers this response to the restriction requirement procedurally appropriate.

I. Inadvertent Filing of Amendment for App. No. 10/842,173 in Subject App. No. 10/727,149 Leading to Restriction Requirement

On October 15, 2007, Applicant filed an Amendment in response to a June 14, 2007 Office Action in subject App. No. **10/727,149.** On that same day, Applicant also filed an Amendment in response to an Office Action in a different application, App. No. **10/842,173**. The correct Amendment was filed in App. 10/842,173, but through clerical error or other oversight, the Amendment for App. No. 10/842,173, rather than the Amendment for App. No. 10/727,149, was inadvertently filed in App. No. 10/727,149.

The result of this inadvertent error is evident by comparing the claims of these two applications, and the fact that the claims that were inadvertently filed in App. No. 10/727,149 differ from the claims that were pending in App. No. 10/727,149 before October 15, 2007. Moreover, the remarks in the Amendment that was inadvertently filed in App. No. 10/727,149 address different matters in a different Office Action.

On December 27, 2007, a restriction requirement was issued in App. No. 10/727,149. The restriction requirement, however, addressed claims that were never presented earlier in App. No. 10/727,149 (since they were claims of Application No. 10/842,173), and was issued in response to an Amendment that did not cancel the previously pending claims, did not include claim "new" claim identifiers to reflect that Applicant intended to cancel and replace the previously pending claims of App. No. 10/727,149 with new claims, and included "currently amendment" identifiers for claims that were not present or pending in App. No. 10/727,149.

In order to rectify Applicant's inadvertent error in an efficient manner, Applicant hereby "responds" to the restriction requirement by canceling the inadvertently submitted claims 1-28, and presenting "new" claims 29-62, which correspond to claims 1-4, 7-15, 18-28, 30-31, 34-37, 47-50 that were pending prior to October 15, 2007, with amendments to said former claims 1, 12, 23 and 50. In particular, each of new independent claims 29, 38 and 47 includes an added limitation "the suction region being between the non-coagulative element and the stimulation

energy sensing element" and new claim 62 includes an added limitation "the suction region being between the non-coagulative means for stimulating tissue and the means for sensing stimulation energy." The preamble of each new independent claim also recites *inter alia* a coagulation element "for ablating tissue."

For ease of cross-referencing in the following remarks, Applicant has retained the original claim numbers (in parentheses) in the remarks such that it is easier for the Examiner to match Applicant's remarks to the June 15, 2007 Office Action.

With entry of this Amendment, the correct claim "amendments" and remarks are presented in response to the June 15, 2007 Office Action, and reference made to the "Office Action" in the ensuing remarks refers to the June 15, 2007 Office Action. Applicant submits that prosecution on the merits can and should be resumed.

II. Withdrawn Rejections

Applicant kindly acknowledges that all prior rejections are obviated. Office Action (p. 2). The following remarks are submitted in response to new rejections based on U.S. Patent No. 6,849,075 to Bertolero *et al.* (hereafter referred to as "Bertolero").

III. Claims Satisfy the Written Description Requirement

All of the pending claims are rejected under 35 U.S.C. §112 as allegedly failing to comply with the written description requirement on the basis that "non-coagulative" as recited in independent claims 29, 38, 47 and 62 (claims 1, 12, 23 and 50) is not found or described in the specification. Whenever a written description issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. MPEP §2163.02. Applicant respectfully traverses the rejection.

The specification of the subject application describes a coagulation element and explains that tissue coagulation involves ablating or killing tissue. *See, e.g.*, col. 1, lines 12-20. The specification also describes a stimulation element, which different than a coagulative element, and explains "The surgical device may also be used in conjunction with tissue stimulation apparatus, such as pacing and recording apparatus, which supply power that stimulates (but does not coagulate) tissue. *See,* col. 7, lines 1-13 (emphasis added). *See also,* p. 23, lines 27-29 ("tissue stimulation energy is provided by a tissue stimulation apparatus 300 that is capable of

providing a pulse of energy that stimulates (but does not coagulate) tissue," p. 29, lines 21-25 (stimulation and sensing electrodes are relatively small (too small to form a transmural myocardial lesion)); p. 33, line 25 - p. 39, line 4. It is also well understood, as noted above, that a coagulation element is different than a stimulation element and has different functionality compared to a stimulation element, hence their different names, functionally and applications as described in the specification.

Claims 29, 38, 47 and 62 include limitations (claims 1, 12, 23 and 50 are amended) to further differentiate a coagulation element and a stimulation element by reciting that the coagulation element is used "for ablating tissue." *See, e.g.*, col. 1, lines 12-20; p. 19, line 28 - p. 23, line 17. Applicant respectfully submits that claims reciting "a non-coagulative stimulation element on the main body" satisfy the written description requirement and convey with clarity that Applicant possessed the invention now claimed, particularly considering that there is no requirement that a claim amendment must include exactly the same nomenclature as provided in the specification. MPEP §608.01(o). Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. §112 be withdrawn. If the rejection stands, Applicant respectfully requests clarification how "non-coagulative" fails to satisfy the written description requirement in view of the descriptions provided by the specification and there being no requirement that a claim amendment must include exactly the same nomenclature as provided in the specification.

IV. Claims 29-58 and 62 (Claims 1-4, 7-15, 18-28, 30, 31, 34-37 and 50) Are Novel Over Bertolero

Independent claims 29, 38, 47 and 62 (claims 1, 12, 23 and 50) and respective dependent claims 30-37, 39-46 and 48-58 (claims 2-4, 7-11, 13-15, 18-22, 24-28, 30, 31 and 34-37) stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Bertolero. Applicant respectfully submits that the cited reference cannot support a rejection of these claims as amended.

Bertolero fails to disclose, teach or suggest the structural combination of "the suction region being between the non-coagulative stimulation element and the stimulation energy sensing element" and " a connector located between the stimulation element and the stimulation energy sensing element" as recited in independent claims 29, 38 and 47 (claims 1, 12 and 23). Bertolero also fails to disclose, teach or suggest "the suction region being between the non-

coagulative means for stimulating tissue and the means for sensing stimulation energy" as recited in claim 62 (claim 50).

The Examiner takes the position that the tissue contacting surface 224 (of a tissue contacting member 102) described by Bertolero is a "main body" as recited in these claims, the suction apertures 212 form a "suction region," the sensors 214 (col. 14, lines 41-63) are a "simulation" element and a "stimulation energy sensing" element and the trough 250 is a "connector." Based on these assumptions and allegations, however, Bertolero cannot anticipate claims 1, 12, 23 and 50 since the suction apertures 212 are formed in the tissue contacting surface 224 of a tissue contacting member 102 in a line along an edge of the tissue contacting member 102. Bertolero (Fig. 2; col. 14, lines 1-18). Consequently, there is no suction aperture 212 on a tissue contacting member 102 that is between sensors 214. Moreover, trough 250 and suction aperture 212 components of a tissue contacting member 102 are not between sensors 214.

Therefore, Applicant respectfully submits that independent claims 29, 38, 47 and 62 (claims 1, 12, 23 and 50) are novel over Bertolero. Dependent claims 30-37, 39-46, 48-58 (claims 2-4, 7-11, 13-15, 18-22, 24-28, 30, 31 and 34-37) incorporate the elements and limitations of respective independent claims 29, 38, 47 and 62 (claims 1, 12, 23 and 50) and, therefore, are also believed novel over Bertolero.

Further, Bertolero fails to disclose, teach or suggest "wherein the suction region comprises first and second suction ports and the connector is positioned between the first and second suction ports" as recited in claims 35 and 44 (claims 9 and 20). Fig. 2 of Bertolero shows a trough 250 (the alleged "connector"), but the suction apertures 212 are formed in a surface 224 of a tissue contacting member 102 as a line of apertures 212 along an edge of the tissue contacting member 102. Therefore, the trough 250 is not between first and second suction ports.

Bertolero also fails to disclose, teach or suggest "the stimulation energy sensing element is adjacent to the first suction port; and the stimulation element is adjacent to the second suction port" as recited in claims 36 and 45 (claims 10 and 21). Applicant notes that claims 29 and 38 (claims 1 and 12) also recite "a connector located between the stimulation element and the stimulation energy sensing element." Thus, a simulation element and sensing element are on opposite sides of the connector, and a sensing element on one side of the connector is adjacent a first suction port, and a simulation element on the other side of the connector is adjacent to another suction port. Bertolero, in contrast, shows a line of suction apertures 212 along one edge

of a tissue contacting member 102 and a line of sensors on one side of the trough 250 along the opposite edge of the tissue contacting member 102. Bertolero (Fig. 2).

In view of the above remarks, Applicant respectfully submits that the rejection of claims 29-58 and 62 (claims 1-4, 7-11-15, 18-28, 30, 31, 34-37 and 50) under 35 U.S.C. §102(e) be withdrawn.

V. Claims 59-61 (Claims 47-49) Are Patentable Over Bertolero

Dependent claims 59-61 (claims 47-49) stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bertolero. Dependent claims 59-61 (claims 47-49) incorporate the elements and limitations of respective independent claims 29, 38 and 47 (claims 1, 12 and 23) and, therefore, are also believed allowable.

Accordingly, Applicant respectfully requests that the rejection of dependent claims 59-61 (claims 47-49) under §103(a) be withdrawn.

CONCLUSION

Applicant respectfully requests entry of this Amendment, and submits that doing so will place the application in condition for allowance in view of the forgoing amendments and remarks. If there are any remaining issues that can be resolved by telephone, Applicant invite the Examiner to kindly contact the undersigned at the number indicated below.

Respectfully submitted,

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